

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LADDIE L. JAMES

Appeal No. 2005-0955
Application No. 09/642,868

ON BRIEF

Before OWENS, TIMM and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-21.

Claims 1, 5, 7, and 9 are representative of the subject matter on appeal and are set forth below:

1. A tack spraying device mountable on a vehicle comprising:

an engine having an exhaust pipe for emitting exhaust gases during the operation of the engine, the engine being mountable to the vehicle,

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a storage tank for maintaining tack material stored in the storage tank under pressure during operation,

a first line connecting the exhaust pipe of the engine to the storage tank in a manner to permit transfer of the engine exhaust to the interior of the storage tank and to serve as a source of the pressure within the storage tank, and

a second line connecting the storage tank to a spray nozzle in a manner to transfer the tack material in the storage tank to the spray nozzle.

5. A tack spraying device according to claim 2 wherein the predetermined pressure level is set a pressure sufficient to transfer the tack material from the storage tank to the spray nozzle at a rate of at least 0.02 gallons per square yard.

7. A tack spraying device according to claim 1 wherein the spray nozzle has an orifice with a nominal diameter of at least 0.375 inches and has a capacity to permit at least 14 gallons per minute of tack material to flow through the orifice at a pressure of at least about 3 psig with a spray angle of at least 75°.

9. A tack spraying device having a tack material storage tank and a line operatively attached to the storage tank and a spray nozzle to permit tack material in the storage tank to flow to and through the spray nozzle, the improvement to which comprises the spray nozzle has an orifice with a nominal orifice diameter greater than any polymer ball that may develop in the storage tank during spraying of the tank material.

The examiner relies upon the following references as evidence of unpatentability:

Haupt	2,076,780	Apr. 13, 1937
Furman et al. (Furman)	3,425,407	Feb. 04, 1969
Herzog	5,522,543	Jun. 04, 1996

Clark, Jr. et al. (Clark, Jr.) 5,957,621

Sep. 20, 1999

We note that we use the supplementary brief filed on October 6, 2003, in this decision, hereinafter referred to as "brief". Appellant has also filed a reply brief on April 16, 2004, in response to the examiner's answer of Paper No. 17, mailed January 13, 2004.

I. Claims 1-4 and 12-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Herzog.

II. Claims 1-4, and 12-16 stand rejected under 35 U.S.C. § 103 as being obvious over Herzog in view of Furman and Haupt.¹

III. Claims 7-11 and 19-21 stand rejected under 35 U.S.C. § 103 as being obvious over Herzog in view of Furman and Haupt.

IV. Claims 5, 6, 17, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Herzog or the combination of Herzog in view of Furman in view of Haupt, and further in view Clark, Jr.²

¹ We note that the claims indicated as being rejected on page 3 of the answer for this rejection, differ from the claims as indicated as being rejected on pages 5 and 7 of the answer. Accordingly, we have separated the rejection of claims 1-4 and 12-16 from the rejection of 7-11 and 19-21, even though the same combination of references apply, to reflect the examiner's presentation on pages 5 and 7 of the answer.

² We note that on page 6 of the answer, the examiner does not include the reference of Kirchner in this rejection. On page 3 of the answer, the examiner applies Kirchner as a reference. Yet, Kirchner is not listed with the other listed references on pages 2-3 of the answer. Also, on page 10 of the answer, the examiner indicates that, in another 35 U.S.C. § 103 rejection involving the reference of Kirchner, that the rejection has been withdrawn. Therefore, we believe that the reference of Kirchner has also been withdrawn from this rejection, and therefore Kirchner is omitted here.

teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990). Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Ex parte Skinner, 2 USPQ2d 1788, 1789 (BPAI 1986). Also, the examiner has the initial burden of providing such evidence or technical reasoning. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986).

Upon review of the examiner's position and the evidence of record, we agree with appellant that the examiner has not met the required burden. Id. While the examiner asserts the structure of Herzog is capable of spraying tack, the examiner does not make findings with regard to the spray heads 91 of Herzog to support his assertion that Herzog's structure necessarily is spraying tack material and transferring tack material to a spray nozzle, while using engine exhaust as the source of pressure. Herzog does not disclose details of the structure of the spray heads 91. Hence, there is not factual foundation to support the examiner's inherency theory. We need not address the pressure value arguments discussed in the answer, brief, and reply brief, in making this determination.

In view of the above, we reverse the 35 U.S.C. § 102(b) rejection of claims 1-4 and 12-16 as being anticipated by Herzog.

II. The 35 U.S.C. § 103 rejection of claims 1-4, and 12-16 as being obvious over Herzog in view Furman and Haupt

The examiner's position for this rejection is set forth on pages 5-6 of the answer.

Appellant's primary argument is that the combination of Herzog, Furman, and Haupt does not suggest "that one could use an engine exhaust to pressurize and apply tack." See the paragraph bridging pages 12-13 of the brief. The examiner's rebuttal is set forth on pages 8-9 of the answer. The examiner reiterates his conclusion that it would have been obvious to provide the device of Herzog with a tack material for spraying, as suggested by Haupt and Furman.

On page 4 of the reply brief, appellant also states that appellant "takes issue with the examiner's reading of Furman." Appellant states that Furman describes his process as a method of spraying a liquid substance, and refers to col. 2, line 11 of Furman. Appellant states that from this, the examiner infers that the device of Furman will work for "any type of material." Appellant argues that the examiner's reading of Furman in this regard is overly broad.

In the instant rejection, the examiner relies upon Haupt and Furman for curing the deficiency of Herzog (the deficiency being that it has not been established that the device in Herzog (wherein engine exhaust is used as the source of pressure), is capable of being a tack spraying device and is capable of transferring tack). Answer, pages 5-6.

We agree with appellant that Furman does not teach spraying of tack material; hence, Furman does not cure the aforementioned deficiency of Herzog.

With regard to Haupt, Haupt discloses discharging bituminous materials such as asphalt or tar, but Haupt's system uses a pump as the source of pressure rather than the exhaust gas of an engine as the source of pressure. Haupt also does not discuss pressure values. Incorporation of Haupt's tack spraying apparatus (using a pump), into Herzog's device, does not arrive at the claimed subject matter of appellant's claim 1 because claim 1 requires use of engine exhaust as a source of pressure for tack spraying.

Hence, each of Furman and Haupt do not provide teachings that would have motivated one skilled in the art to have modified Herzog's device to obtain a tack spraying device that transfers tack material to a spray nozzle, using exhaust gas as the source of pressure.

In view of the above, we reverse the 35 U.S.C. § 103 rejection of claims 1-4 and 12-16 as being obvious over Herzog in Furman and Haupt.

III. The 35 U.S.C. § 103 rejection of claims 7-11 and 19-21 as being obvious over Herzog in view Furman and Haupt

The examiner uses the very same combination of references (Herzog, Furman, and Haupt), as used in the above-discussed obviousness rejection. Hence, for the same reasons that we reversed the aforementioned obviousness rejection, we also reverse this rejection.

Therefore, the 35 U.S.C. § 103 rejection of claims 7-11 and 19-21 as being obvious over Herzog in view Furman and Haupt is reversed.

IV. The 35 U.S.C. § 103 rejection of claims 5, 6, 17 and 18 has being obvious of Herzog or the combination of Herzog in view of Furman and Haupt, further in view of Clark, Jr.

The examiner's position for this rejection is set forth on pages 9-10 of the answer. Appellant's position regarding this rejection is set for on pages 13-15 of the brief and on page 6 of the reply brief.

These claims concern a pressure level that is sufficient to transfer the tack material from the storage tank to the spray nozzle at a particular rate. The examiner's position is that Herzog's device is capable of sustaining the rate disclosed in Clark, Jr. As such, the examiner concludes that it would have been obvious to combine a higher pressure system with a higher dispensing rate device.

As discussed above, the examiner has not established that Herzog's device is capable of spraying tack (regardless of what rate or pressure level used). The examiner has also not established obviousness in view of the combination of Herzog in view of Furman in view of Haupt. Because Clark, Jr. does not cure the deficiency of Herzog, or the deficiency of the combination of Herzog in view of Furman in view of Haupt, we reverse this rejection.

In view of the above, we therefore reverse the 35 U.S.C. § 103 rejection of claims 5, 6, 17 and 18 as being obvious over Herzog or the combination of Herzog, Furman, and Haupt, in combination with Clark, Jr.

V. Conclusion

Each of the rejections is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

Terry J. Owens
TERRY J. OWENS

Administrative Patent Judge

Catherine Timm
CATHERINE TIMM

Administrative Patent Judge

Beverly A. Pawlikowski
BEVERLY A. PAWLIKOWSKI

Administrative Patent Judge

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WILLIAM DAVID KIESEL
P.O. BOX 15928
BATON ROUGE, LA 70895